



Attorney Docket No.: 5849.200-US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Berka et al.

Confirmation No: 6980

Serial No.: 09/533,559

Group Art Unit: 1631

Filed: March 22, 2000

Examiner: J.S. Brusca

For: Methods For Monitoring Multiple Gene Expression

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby certify that the attached correspondence comprising:

1. Amendment Fee Transmittal (in duplicate)
2. Amendment

is being deposited with the United States Postal Service as first class mail in an envelope addressed to the address indicated above on April 6, 2004.

Seleste A. Buriani
(name of person mailing paper)

Seleste A. Buriani
(signature of person mailing paper)



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AMENDMENT FEE TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an Amendment for the above-identified application in response to the Office Action mailed **November 6, 2003**.

It is respectfully requested that the time for response to the Office Action be extended for a period of **2 months from February 7, 2004 to April 6, 2004**. The required fee for the extension is estimated to be **\$420.00**.

No additional claims fee is required.

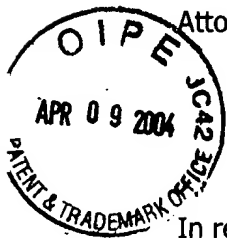
Please charge the required extension and claims fees, estimated to be **\$420.00**, to Novozymes North America, Inc., Deposit Account No. 50-1701. A duplicate of this sheet is enclosed.

Respectfully submitted,

Date: April 6, 2004

Robert L. Starnes, Reg. No. 41,324
Novozymes Biotech, Inc.
1445 Drew Avenue
Davis, CA 95616
(530) 757-8100

Image



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AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

This amendment is in response to the Office Action dated November 6, 2003. Claims 103-110 are pending in the present application. It is respectfully submitted that the present amendment presents no new issues or new matter and places this case in condition for allowance. Reconsideration of the application in view of the following remarks is requested.

I. The Rejection of Claims 103-110 under 35 U.S.C. § 101

Claims 103-110 remain rejected under 35 U.S.C. § 101 on the ground that the claimed invention lacks patentable utility. The Office Action states:

The claimed combination of nucleic acids is not supported by a substantial utility because no substantial utility has been established for the claimed subject matter. The disclosed utility is to use an array of *Aspergillus oryzae* ESTs to determine expression profiles that are correlated with different types of cells or different growth states of cells. No evidence has been disclosed that the elected SEQ ID NOS allow for determination of the state or type of cell that is assayed by the claimed method of using an array of *Aspergillus oryzae* ESTs. Further research is required to determine whether the claimed method utilizes ESTs that allow for useful discrimination between cell types or cell states. The research required to establish the utility of the claimed method is not consistent with a substantial utility. Identifying and studying the properties of an array of ESTs does not define a "real world" context or use. Neither the specification as filed nor any art of record discloses or suggests any property or

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Adjustment date: 04/13/2004 EFLORES

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